UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,707	07/03/2001	Thomas Zickell	NEI-010XX	2439

7590 01/20/2004

Bourque & Associates, P.A.
Suite 303
835 Hanover Street
Manchester, NH 03104

EXAMINER	
AUGHENBAUGH, WALTER	
ART UNIT	**PAPER NUMBER**
1772	8

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/898,707	ZICKELL, THOMAS	
	Examiner	Art Unit	
	Walter B Aughenbaugh	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 October 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *16-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☒ Claim(s) *10* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claims 1-3, 8, 9 and 12-15 in the Amendment filed October 30, 2003 (Paper 7) have been received and considered by Examiner.

2. Applicant's arguments presented in Paper 6 have been received and considered by Examiner.

WITHDRAWN OBJECTIONS

3. The objection to claim 2 made of record in paragraph 1 of Paper 4 has been withdrawn due Applicant's amendments to claim 2 in Paper 7.

WITHDRAWN REJECTIONS

4. The 35 U.S.C. 112 rejection of claims 2, 8 and 12 made of record in paragraph 3 of Paper 4 has been withdrawn due to Applicant's amendments to claims 2, 8 and 12 in Paper 4.

5. The 35 U.S.C. 103 rejection of claims 1, 3, 4, 9 and 11-13 over Simpson et al. in view of McGroarty et al. made of record in paragraph 5 of Paper 4 has been withdrawn due to Applicant's amendment to claim 1 in Paper 7 (i.e. the replacement of "a decorative material" with --granules-- in the ninth line of the claim).

REPEATED REJECTIONS

6. The 35 U.S.C. 112 rejection of claims 3 and 13-15 has been repeated for reasons previously made of record in paragraph 3 of Paper 4. The reasons for rejection of claim 3 under 35 U.S.C. 112 have been withdrawn except for the reason directed to the term "wider": the direction intended to be recited by the term "wider" relative to the covering material cannot be ascertained- what is the "length" relative to the covering material and what is the "width"

relative to the covering material? The reasons for rejection of claims 13 and 15 under 35 U.S.C. 112 have been withdrawn except for the reason directed to the basis of the term "amount": is -- by weight-- the basis of the term "amount" ("about twice an amount" by weight)? If not, what is the basis of the term "amount"? The reasons for rejection of claim 14 under 35 U.S.C. 112 have been withdrawn except for the reason directed to the lack of antecedent basis of the limitation "said bottom"; the phrase "said bottom lower" does not overcome the rejection.

7. The 35 U.S.C. 103 rejection of claims 5-8 and 10 over Simpson et al. in view of McGroarty et al. and in further view of Kennepohl et al. made of record in paragraph 6 of Paper 4 has been repeated for the reasons previously made of record in paragraph 6 of Paper 4, taking into account the new 35 U.S.C. 103 rejection of claim 1 over Simpson et al. in view of McGroarty et al. and in further view of Kennepohl et al. presented below in this Office Action.

NEW OBJECTIONS

Claim Objections

8. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. "[G]ranules adhered to said asphalt composition" as claimed in claim 1 is a "granular material deposited on said asphalt composition" as claimed in claim 10; therefore, claim 10 fails to further limit claim 1.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

9. Claims 1-3, 10 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said decorative surface areas" in the 16th-17th lines of the claim. There is insufficient antecedent basis for this limitation in the claim; the 6th-7th lines of claim 1 recite "a decorative surface area", i.e. one decorative surface area.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the structural relationship between the parting agent covered surface area, the substrate and the clean surface area; the phrase "generally opposite" does not definitely recite the structural relationship between the parting agent covered surface area, the substrate and the clean surface area.

Claim 3 recites the limitation "said parting agent surface area" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "said decorative material" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

In regard to claims 13 and 15, the claims are indefinite because while the claims establish that "said asphalt composition and said adhesive composition have a fuel content" the claim language requires that the fuel contents of the two compositions are different; two compositions

that "have a fuel content" (i.e. one fuel content) cannot have different fuel contents. This discrepancy must be corrected. Claims 13 and 15 recite the limitations "said fuel content of said asphalt composition" and "said fuel content of said adhesive composition". There is insufficient antecedent basis for these limitations in the claims in the case where the fuel contents of the two compositions are different as recited in the last four lines of claim 13 and in lines 6-8 of claim 15.

Claim 14 recites the limitation "said bottom lower" in the 11th-12th lines of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 14 recites the limitation "said two adjacent rolled roofing membranes" in the 14th-15th and 17th-18th lines of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 14 recites the limitation "said granular materials" in the 16th-17th lines of the claim. There is insufficient antecedent basis for this limitation in the claim; the claim recites "a granular material" in singular form in the 9th line of the claim.

Claim Rejections - 35 USC § 103

10. Claims 1-4, 9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of McGroarty et al., and in further view of Kennepohl et al.

In regard to claim 1, Simpson et al. teach a rolled covering material (col. 6, lines 19-34 and 56-58), for use in covering a support surface by overlapping adjacent strips of the covering material (col. 6, lines 35-38), comprising a substrate having upper and lower surfaces (impregnated mat, item 92, col. 5, lines 34-54), an asphalt composition saturating the substrate (col. 5, lines 48-54) and coating the upper surface of the substrate to form a decorative surface area (coating, item 24, col. 3, lines 25-29 and col. 4, lines 36-39) on the upper surface of the

substrate, an adhesive composition disposed on at least a portion of the bottom surface of the substrate to form an adhesive surface area (adhesive, item 94, col. 5, lines 48-62) and a release backing disposed over the adhesive surface area (release paper, item 96, col. 5, lines 48-62).

The phrase "for use in covering a support surface by overlapping adjacent strips of said covering material" (lines 1-2) is an intended use phrase that has not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987).

Simpson et al. fail to teach that the asphalt composition saturating the substrate coats a portion of the upper surface of the substrate to form a clean surface area on the upper surface of the substrate wherein the adhesive surface area adheres to the clean surface area when overlapping strips of two adjacent covering materials are applied to cover the support surface such that substantially only the decorative surface area is exposed and fail to teach granules adhered to the asphalt composition on the decorative surface area.

McGroarty et al., however, disclose a waterproofing sheet (item 10) that is especially valuable for use on roofs, having an edge portion (item 13, Fig. 1) that is left without the layers that are coextensive over the remainder of the sheet (excluding edge portion, item 13) so that the sheets can be lapped so that the sheets, when installed (i.e. fastened via an adhesive, col. 2, line 61), provide a continuous impervious layer (col. 2, line 49-col. 3, line 11 and Fig. 1 and 2) (i.e. the adhesive surface area adheres to the clean surface area when overlapping strips of two adjacent covering materials are applied to cover the support surface such that substantially only the decorative surface area is exposed). Furthermore, Simpson et al. teach that a decorative

material is adhered to the asphalt composition on the decorative surface area (aluminum foil sheet, item 18, col. 3, lines 11-19) and that the purpose of the aluminum foil sheet is to reflect infrared and ultraviolet rays impinging on the roof from the sun (col. 1, lines 40-49). Kennepohl et al. teach a coating of decorative, reflective finely divided stone (i.e. granules) on the asphalt composition (col. 1, lines 38-48). Therefore, one of ordinary skill in the art would have recognized to have replaced the aluminum foil taught by Simpson et al. with the granules taught by Kennepohl et al. since Kennepohl et al. teach the use of the granules as a reflective material, as the aluminum foil taught by Simpson et al. is used as a reflective material, and to have coated the asphalt composition on the upper surface of the substrate to form a clean surface area on the upper surface of the substrate in order to enable strips of the covering material to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the aluminum foil taught by Simpson et al. with the granules taught by Kennepohl et al. since Kennepohl et al. teach the use of the granules as a reflective material, as the aluminum foil taught by Simpson et al. is used as a reflective material, and to have coated the asphalt composition on the upper surface of the substrate of Simpson et al. to form a clean surface area on the upper surface of the substrate of Simpson et al. in order to enable strips of the covering material to be lapped together so that the sheets of Simpson et al., when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

In regard to claim 2, Simpson et al. teach that the rolled covering material further includes a parting agent covered surface area (the silicon compound release coating, col. 3, lines

32-35) of the bottom surface of the substrate that necessarily resists (because it is a release coating) adhering to the clean surface area of the rolled covering material (of Simpson et al., McGroarty et al. and Kennepohl et al.) when the covering material is rolled that is generally opposite the clean surface area of the rolled covering material of Simpson et al., McGroarty et al. and Kennepohl et al. since the clean surface area as claimed in claim 1 is on the upper surface of the substrate.

In regard to claim 3, Simpson et al. fail to teach that the width of the decorative surface area ("W2") is wider than the width of the parting agent covered surface area ("W1"). McGroarty et al., however, disclose a waterproofing sheet (item 10) that is especially valuable for use on roofs, having an edge portion (item 13, Fig. 1) that is left without the layers that are coextensive over the remainder of the sheet (excluding edge portion, item 13) so that the sheets can be lapped so that the sheets, when installed, provide a continuous impervious layer (col. 2, line 49-col. 3, line 11 and Fig. 1 and 2). Furthermore, McGroarty et al. teach that the decorative surface area (the membrane, item 10, Fig. 1, col. 4, lines 51-52) is wider than the surface area of the adhesive waterproofing layer (item 11, col. 4, lines 55-60) that corresponds to the adhesive surface area of Simpson et al., the layer that would be covered by the parting agent according to the teachings of Simpson et al. (see Fig. 1). Therefore, one of ordinary skill in the art would have recognized to have coated the adhesive surface area of Simpson et al. on the substrate of Simpson et al. such that the decorative surface area of Simpson et al. is wider than the surface area of the parting agent covered surface area as taught by McGroarty et al. in order to enable strips of the covering material to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have coated the adhesive surface area of Simpson et al. on the substrate of Simpson et al. such that the decorative surface area of Simpson et al. is wider than the surface area of the parting agent covered surface area as taught by McGroarty et al. in order to enable strips of the covering material to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

In regard to claim 4, Simpson et al. teach that the substrate includes a fibrous material (non-woven polyester fiber mat, item 92, col. 5, lines 45-62). In regard to claim 9, Simpson et al. teach that the surface of the substrate (mat, item 92), and therefore the clean surface area of the substrate taught by Simpson et al., McGroarty et al. and Kennepohl et al., is roughened in texture due to unwoven polyester fibers (col. 5, lines 55-60), and therefore, that the clean surface area has exposed fibers on the upper surface of the substrate. In regard to claim 11, Simpson et al. teach that the adhesive composition includes a rubberized asphalt material (col. 6, lines 21-34; styrene-butadiene radial block polymer is a rubber).

In regard to claim 12, Simpson et al. teach that the adhesive composition includes by weight 13% styrene-butadiene block polymer, 12% sand (filler), 7% oil and 63% bitumen (flux asphalt, col. 4, lines 35-39). Normally, it is to be expected that minor changes in the relative amounts of rubber, filler, oil and asphalt in an asphalt based adhesive would be an unpatentable modification. Under some circumstances, however, changes such as a change to the relative amounts of rubber, filler, oil and asphalt in an asphalt based adhesive may impart patentability to an article if the particular ranges claimed produce a new and unexpected result which is different

in kind and not merely in degree from the results of the prior art. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

In regard to claim 13, while Simpson et al., McGroarty et al. or Kennepohl et al., do not explicitly teach that an amount of the asphalt composition is about twice an amount of the adhesive composition to improve fire resistance, the substrate (item 92) which comprises the asphalt composition and the coating (item 24) of the asphalt composition of Simpson et al. are depicted as being thicker than the single adhesive layer (item 94) (Fig. 1 and 9). Therefore, one of ordinary skill in the art would have recognized that the asphalt composition is present in the covering material taught by Simpson et al. or McGroarty et al. in a larger amount than the adhesive composition. Futhermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have adjusted the relative amounts of the asphalt and adhesive compositions, and the relative fuel contents of the asphalt and adhesive compositions, via routine experimentation in order to determine the relative amounts (and relative fuel contents) of the asphalt and adhesive compositions that yield the optimum fire resistance depending on the desired end user result, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In regard to claim 14, Simpson et al. teach a rolled roofing membrane (col. 6, lines 19-34 and 56-58), for use in covering a roof by overlapping adjacent strips of the roofing membrane (col. 6, lines 35-38), comprising a substrate having upper and lower surfaces (impregnated mat, item 92, col. 5, lines 34-54), an asphalt composition saturating the substrate (col. 5, lines 48-54) and coating the upper surface of the substrate to form a roofing surface area (coating, item 24,

col. 3, lines 25-29 and col. 4, lines 36-39) on the upper surface of the substrate, an adhesive composition disposed on the bottom surface of the substrate to form an adhesive surface area (adhesive, item 94, col. 5, lines 48-62) and a release backing disposed over the adhesive surface area (release paper, item 96, col. 5, lines 48-62). Simpson et al. also teach that the rolled roofing membrane comprises a parting agent covering a portion of the lower surface of the substrate to form a parting agent covered surface area (the silicon compound release coating, col. 3, lines 32-35) that necessarily (because it is a release coating) resists adhering to the clean surface area (of Simpson et al., McGroarty et al. and Kennepohl et al.) when the rolled roofing membrane is rolled.

The phrases "for use in covering a roof by overlapping adjacent strips of said roofing membrane" (lines 1-3) and "for preventing said adhesive surface area from adhering to said roofing surface area when said rolled roofing membrane is rolled" (lines 20-22) are intended use phrases that have not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987).

Simpson et al. fail to teach a granular material adhered to the asphalt composition on the roofing surface area and fail to teach that the asphalt composition saturating the substrate coats a portion of the upper surface of the substrate to form a clean surface area on the upper surface of the substrate wherein the adhesive surface area adheres to the clean surface area when overlapping strips of adjacent rolled roofing membranes are applied to cover the roof such that the granular material of the rolled roofing membrane is exposed.

McGroarty et al., however, disclose a waterproofing sheet (item 10) that is especially valuable for use on roofs, having an edge portion (item 13, Fig. 1) that is left without the layers that are coextensive over the remainder of the sheet (excluding edge portion, item 13) so that the sheets can be lapped so that the sheets, when installed (i.e. fastened via an adhesive, col. 2, line 61), provide a continuous impervious layer (col. 2, line 49-col. 3, line 11 and Fig. 1 and 2) (i.e. the adhesive surface area adheres to the clean surface area when overlapping strips of adjacent rolled roofing membranes are applied to cover the roof such that the granular material of the rolled roofing membrane is exposed). Furthermore, Simpson et al. teach that an aluminum foil sheet (item 18) is adhered to the asphalt composition on the roofing surface area (col. 3, lines 11-19) and that the purpose of the aluminum foil sheet is to reflect infrared and ultraviolet rays impinging on the roof from the sun (col. 1, lines 40-49). Kennepohl et al. teach a coating of decorative, reflective finely divided stone (i.e. granular material) on the asphalt composition (col. 1, lines 38-48). Therefore, one of ordinary skill in the art would have recognized to have replaced the aluminum foil taught by Simpson et al. with the granular material taught by Kennepohl et al. since Kennepohl et al. teach the use of the granular material as a reflective material, as the aluminum foil taught by Simpson et al. is used as a reflective material, and to have coated the asphalt composition on the upper surface of the substrate to form a clean surface area on the upper surface of the substrate in order to enable strips of the roofing membrane to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the aluminum foil taught by Simpson et al. with the granular material

taught by Kennepohl et al. since Kennepohl et al. teach the use of the granular material as a reflective material, as the aluminum foil taught by Simpson et al. is used as a reflective material, and to have coated the asphalt composition on the upper surface of the substrate to form a clean surface area on the upper surface of the substrate in order to enable strips of the roofing membrane to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

In regard to claim 15, Simpson et al. teach that the adhesive composition includes a rubberized asphalt material (col. 6, lines 21-34; styrene-butadiene radial block polymer is a rubber). Simpson et al. teach that the asphalt composition includes a mineral filler (e.g. sand, col. 4, lines 25-46); while Simpson et al. and McGroarty et al. fail to teach that the asphalt composition includes an oxidized asphalt, Kennepohl et al. disclose that oxidized asphalt (col. 7, lines 36-55) with a mineral filler (col. 1, lines 20-48) is a notoriously well known noncombustible material for use as roofing. Therefore, one of ordinary skill in the art would have recognized to have oxidized the asphalt composition of Simpson et al. since oxidized asphalt is a notoriously well known noncombustible material for use as roofing as taught by Kennepohl et al. While Simpson et al., McGroarty et al. or Kennepohl et al., do not explicitly teach that an amount of the asphalt composition is about twice an amount of the adhesive composition to improve fire resistance, the substrate (item 92) which comprises the asphalt composition and the coating (item 24) of the asphalt composition of Simpson et al. are depicted as being thicker than the single adhesive layer (item 94) (Fig. 1 and 9). Therefore, one of ordinary skill in the art would have recognized that the asphalt composition is present in the covering material taught by Simpson et al. or McGroarty et al. in a larger amount than the adhesive composition.

Futhermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have adjusted the relative amounts of the asphalt and adhesive compositions, and the relative fuel contents of the asphalt and adhesive compositions, via routine experimentation in order to determine the relative amounts (and relative fuel contents) of the asphalt and adhesive compositions that yield the optimum fire resistance depending on the desired end user result, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

ANSWERS TO APPLICANT'S ARGUMENTS

11. Applicant's arguments on pages 10-15 of Paper 6 regarding the 35 U.S.C. 103 rejection of claims 1, 3, 4, 9 and 11-13 over Simpson et al. in view of McGroarty et al. have been fully considered but are not persuasive.

On page 10 of Paper 6, Applicant argues that "the Examiner has misread Simpson et al." that "Simpson et al. discloses two distinct inventions" and that "the Examiner has improperly combined elements from both of these distinct inventions without indicating how the Examiner is interpreting the reference"; Examiner has not misread Simpson et al. The "two distinct inventions" to which Applicant refers are by no means "distinct inventions" under a patent law definition of "distinct inventions" (MPEP 802.01); the only possible way that Applicant could be interpreting these "inventions" as distinct within the common (dictionary) meaning of "distinct" is that they are depicted in different figures as Applicant has pointed out. However, these "two distinct inventions", as Applicant characterizes them, are plainly disclosed as used together "to enhance the bond between the roof 12 and the roofing 10" and "to strengthen the overall roofing

combination" (col. 5, lines 36-37 and 48), and are therefore not distinct inventions. Since roofing material 10 and underlayment 90 are plainly disclosed as used together in Simpson et al., these elements have in no way been "improperly combined" as Applicant alleges, and there was no need to "indicat[e] how the Examiner is interpreting the reference" in preparing the Office Action (Paper 4) as Applicant contends since the Simpson et al. makes it entirely clear that roofing material 10 and underlayment 90 are used together "to enhance the bond between the roof 12 and the roofing 10" and "to strengthen the overall roofing combination" (col. 5, lines 36-37 and 48).

On page 11 of Paper 6, Applicant states that claim 1 recites "upper side of said substrate"; this phrase is not recited in claim 1. The combination of Simpson et al., McGroarty et al. and Kennepohl et al. as proposed in the 35 U.S.C. 103 rejection of claim 1 presented in this Office Action leads one of ordinary skill in the art to the invention claimed in claim 1.

On page 12 of Paper 6, Applicant argues that "Simpson et al. *teach away* from the use of granules" and that the modification suggested by Examiner (which Applicant seems to have incorrectly interpreted as adding granules to the layer of aluminum foil, see top of page 12 of Paper 4- "replaced") "would change the principal operation of Simpson et al. and render it unsatisfactory for its intended purpose". Applicant's reasoning presumably in support of Applicant's argument actually supports the rejection made of record in paragraph 6 of Paper 4 and the rejection of claim 1 made of record in this Office Action. Applicant points out that Simpson et al. "disclose an improved method of shielding asphalt layers from ultraviolet light" as was similarly stated in paragraph 6 of Paper 4 ("Simpson et al. teach that the purpose of the aluminum foil is to reflect infrared and ultraviolet rays impinging on the roof from the sun"). The

Action goes on to state that "Kennepohl et al. teach [that] a coating of decorative, reflective finely divided stone (i.e. granular material)"; both the aluminum foil of Simpson et al. and the granular material (granules) of Kennepohl et al. are sunray reflective. Therefore, replacement of the aluminum foil of Simpson et al. with the granular material (granules) of Kennepohl et al. in no way "change[s] the principal operation of Simpson et al. and render[s] it unsatisfactory for its intended purpose" as Applicant alleges; the aluminum foil of Simpson et al. and the granular material (granules) of Kennepohl et al. perform the equivalent function of sunray reflection, and replacement of the aluminum foil of Simpson et al. with the granular material (granules) of Kennepohl et al. *preserves* the "principal operation of Simpson et al.". Simpson et al. *does not* teach away from the replacement of sunray reflective aluminum foil with sunray reflective granules.

In the paragraph bridging pages 12 and 13 of Paper 6, Applicant argues that "the layer of aluminum foil 36 is not adhered to the upper surface of the asphalt saturated substrate" and that "the layer of aluminum foil" (which paragraph 5 of Paper 4 establishes as item 18, not item 36) "is adhered to the layer of polyethylene sheet 20 with an ionomer resin adhesive 22". However, just as the aluminum foil layer 18 is adhered to the polyethylene sheet 20 via ionomer resin adhesive layer 22 as Applicant points out, the aluminum foil layer 18 is adhered to the substrate (item 92, i.e. the upper surface of the substrate) via ionomer resin adhesive layer 22, polyethylene sheet 20 and coating 24.

On page 13 of Paper 6, Applicant argues that "the layer of polyethylene sheet 20 does not read on the asphalt saturated substrate", but the Office Action (Paper 4) does not make this contention. Applicant makes the unsupported statement that "the layer of polyethylene sheet 20

cannot be modified to include a clean surface area", but paragraph 5 of Paper 4 provides motivation for why one of ordinary skill in the art would have recognized to have provided a clean surface area in the roofing material of Simpson et al. Applicant alleges that "Simpson et al. disclose that the polyethylene film 20 and the aluminum foil 36 have an identical size" but what is actually stated at col. 3, lines 46-48 that is cited by Applicant is "... squeeze the polyethylene film against a correspondently sized sheet of aluminum foil 36". The meaning of the phrase "correspondently sized" is not limited to "having the same size"; e.g. "correspondently sized" could mean "having the appropriate relative sizes". Applicant's statement that "it would be improper to modify Simpson et al. as suggested" is unsupported.

On page 15 of Paper 6, Applicant contends that "the Examiner has not established that the particular [parameters] in claims [12 and 13- not 13 and 14] are a result effective variable", but the Office Action does not rely on the "result effective variable" principle in rejection of claim 12. As to claim 13, the claim language of claim 13 itself recognizes that the relative amounts of the asphalt and adhesive compositions is a result effective variable in regard to the "fire resistance" of the covering material; therefore, the fact that the relative amounts of the asphalt and adhesive compositions is a result effective variable is established.

12. Applicant's arguments on pages 15-16 of Paper 6 regarding the 35 U.S.C. 103 rejection of claims 8 and 10 over Simpson et al. in view of McGroarty et al. and in further view of Kennepohl et al. have been fully considered but are not persuasive.

In regard to claim 8, Applicant argues that "neither Simpson et al. nor Kennepohl et al. disclose or suggest an asphalt composition including all of the elements"; but claim 8 does not stand rejected under 35 U.S.C. 102, Kennepohl et al. teach that it is known to incorporate

limestone filler into an asphalt composition and the composition taught by Simpson et al. that includes asphalt and SBS rubber is an asphalt composition. Applicant's arguments in regard to the rejection of claim 10 have been refuted above in this Office Action in the discussion of the replacement of sunray reflective aluminum foil with sunray reflective granules.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba
01/13/04 WBA

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/15/04